

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUNDEEP BHAN, JEFF FENIGSTEIN, and JOHN ALFANO

Appeal 2006-3269
Application 10/734,811
Technology Center 3600

Decided: March 7, 2007

Before TERRY J. OWENS, JENNIFER D. BAHR, and LINDA E. HORNER,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the Examiner's final rejection of claims 1-6, 8, 10-15, 17, and 18, all of the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The invention relates to a method of selectively distributing invitations for a plurality of events (Specification 1: [0002]). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method of selectively distributing invitations for a plurality of events, the method comprising the steps of:

storing event information about each of a plurality of events, wherein the event information for each of the plurality of events includes at least one invitee selection criterion;

storing member information about each of a plurality of members;

detecting, for each of the plurality of members, whether the at least one invitee selection criterion for each of the events matches the member information; and

sending an e-mail invitation to at least some of the members for whom a match was detected in the detecting step, wherein the e-mail invitation invites its recipient to at least some of the events for which a match was detected in the detecting step, and

wherein at least one of the e-mail invitations sent in the sending step invites its recipient to a plurality of events for which a match was detected in the detecting steps.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Sarid (Gal)¹ WO 01/52106 A2 Jul. 19, 2001

The Examiner rejected claims 1-6, 8, 10-15, 17, and 18 under 35 U.S.C. § 102(b) as being anticipated by Gal.

ISSUE

Appellants contend that claims 1-6, 8, 10-15, 17, and 18 are not anticipated by Gal, because Gal does not teach or suggest sending a multi-event invitation via email, as required by independent claims 1, 6, and 15 (Br. 6). The Examiner found that Gal anticipates claims 1, 6, and 15, because Gal discloses a method of selectively distributing invitations by email wherein at least one of the email invitations sent in the sending step invites its recipient to a plurality of events (Answer 3-5). The issue before us is whether Appellants have shown that the Examiner erred in finding that Gal anticipates claims 1-6, 8, 10-15, 17, and 18.

FINDINGS OF FACT

A preponderance of the evidence establishes the following facts:

“Email,” shorthand for “electronic mail,” are “messages sent by a user and retrieved by another through an electronic service system, most often via telephone lines or radio transmission.” Jerry M. Rosenberg, *Dictionary of Computers*,

¹ Although the first named inventor is Sarid, the Examiner and Appellants refer to the document throughout by reference to the second named inventor, Gal. To avoid confusion, we refer to the reference as “Gal.”

Information Processing and Telecommunications 202 (2nd ed. 1987) (copy attached).

Gal discloses a system in which a user wishing to send a message visits a Web page run by a Web server, creates the message, and provides profile information about the intended recipients of the message (Gal 3: 6-9).

Gal discloses the system uses the profile information to search a database to obtain a list of recipients and sends the message to the recipients' computers via email or via a dynamically-created Web page (Gal 3: 12-15).

Gal discloses using a relational database 90 to store hobby information, occupation information, and name information about potential recipients in tables, and using profile information provided by a user to search the database for keys corresponding to the profile information. The matching keys are then used in the name table to create a list of email addresses to send the message (Gal 5: 5-14, Figure 4).

Instead of sending individual invitations in email messages, Gal discloses that the relational database 90 can be used, along with the profile information provided by a user, to create invitation tables such as Tables 98 and 100. Each invitation message is associated with a pointer to the message block. The recipients of a message are associated with an invitation number. When a recipient visits the Web page to retrieve the recipient's invitations, a personal Web page is dynamically constructed by searching the database 90 for invitations corresponding to the recipient's key number (Gal 5: 15-20).

Gal discloses that the recipient's computer with a Web browser produces the dynamically-created Web page. The dynamically-created Web page is a personal invitation page for a user of the system. When the user clicks on a personal invitation page, the server produces an HTML document constructed from the database 90. Gal discloses that the user's dynamically-created Web page can contain invitations for multiple events. (Gal 5: 21-25, Figure 5).

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

"[A]rguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 1350-51, 213 USPQ 1, 7 (CCPA 1982)). The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention.)

To determine whether the claims are anticipated, we must first construe the meaning of the word "e-mail" as used by Appellants in the claims. We determine

the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. See *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868-69 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”) The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. See *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

ANALYSIS

Appellants argue all of the claims as a group (Br. 6). As such, we treat claim 1 as the representative claim.

Appellants argue that the Examiner’s definition of email, “electronic communication through a computer,” is too broad (Br. 7-8). Appellants contend

that “email” is “a specific type of ‘electronic communication through a computer’” (Br. 8). Appellants, however, fail to specify exactly what “type” of electronic communication through a computer qualifies as the claimed “e-mail.” We find that email refers to messages sent by a user and retrieved by another through an electronic service system.

As stated *supra*, Gal discloses a method of selectively distributing invitations for a plurality of events. Gal’s system sends to the recipient a dynamically-created Web page, which includes textual messages inviting the recipient to a plurality of events. The dynamically-created Web page is sent to the recipient via the recipient’s Web browser when the recipient visits the Web site to retrieve the recipient’s invitations. As such, the dynamically-created Web page falls within the scope of the claimed “e-mail invitation” because the dynamically-created Web page is an electronic communication from the Web server to the recipient through the recipient’s Web browser that communicates textual messages (i.e., invitations to multiple events) to the recipient. Gal’s system stores the invitations in its database (shown in Figure 4) and then forwards the invitations to the recipient via the dynamically-created Web page (e-mail) when requested to do so by the recipient via the recipient’s Web browser. Thus, Gal anticipates the invention as claimed in independent claims 1, 6, and 15, which includes sending email invitations where at least one of the invitations invites its recipient to more than one event.

Appellants argue that Gal teaches away from the method of claim 1 because Gal acknowledges drawbacks with sending separate emails for each invitation (Br.

7). As stated *supra*, the question whether a reference “teaches away” from the invention is inapplicable to an anticipation analysis. Further, we do not rely on Gal’s disclosure of separate emails for each invitation as the basis for our finding of anticipation. Rather, we affirm the Examiner’s finding of anticipation based on Gal’s use of a dynamically-created web page to send invitations for multiple events to a recipient.

CONCLUSIONS OF LAW

We conclude that the Examiner did not err in rejecting claims 1-6, 8, 10-15, 17, and 18 under 35 U.S.C. § 102(b) as anticipated by Gal.

DECISION

The decision of the Examiner to reject claims 1-6, 8, 10-15, 17, and 18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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Application 10/734,811

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